

**SEALED BY ORDER OF THE COURT****FILED**

Mar 12 2021

SUSAN Y. SOONG  
 CLERK, U.S. DISTRICT COURT  
 NORTHERN DISTRICT OF CALIFORNIA  
 SAN JOSE

UNITED STATES DISTRICT COURT  
 NORTHERN DISTRICT OF CALIFORNIA  
 SAN JOSE DIVISION

FINJAN LLC,  
 Plaintiff,  
 v.  
 SONICWALL, INC.,  
 Defendant.

Case No. 17-cv-04467-BLF

**ORDER ON MOTION TO STRIKE**

Before the Court is SonicWall's Motion to Strike New Theories. Mot., ECF 299; *see also* ECF 300 (redacted brief). SonicWall requests that the Court strike five theories and associated portions of expert reports. *See generally* Mot. On March 5, 2021, the Court issued its Order on SonicWall's Motion for Partial Summary Judgment. ECF 381. This Order mooted SonicWall's request as to theories one, four, and five. *See* ECF 403. Accordingly, the Court WITHDRAWS its referral of theories four and five to Judge Virginia K. DeMarchi. ECF 345. Theory two, which concerns the '408 Patent, and theory three, which concerns the '708 Patent, are the only remaining theories before this Court.

This district's Patent Local Rules require both parties to provide early identification of their respective infringement and invalidity theories. *See* Patent L.R. 3-1, 3-3. Once served, the contentions constitute the universe of the parties' respective theories, and those contentions may be amended only by order of the court and upon a showing of good cause. Patent L.R. 3-6. As has been recognized by many courts, the purpose of these disclosures is to "require parties to crystallize their theories of the case early in the litigation," *O2 Micro Int'l Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d 1355, 1364 (Fed.Cir.2006) (quoting *Atmel Corp. v. Info. Storage Devices, Inc.*, No. C 95-1987 FMS, 1998 WL 775115, at \*2 (N.D.Cal.1998)), so as to "further the goal of full, timely discovery

1 and provide all parties with adequate notice of and information with which to litigate their cases,”  
2 *Genentech, Inc. v. Trustees of Univ. of Pennsylvania*, Case No. 10-cv-2037, 2012 WL 424985, at  
3 \*2 (N.D.Cal. Feb. 9, 2012) (citation and internal quotation marks omitted). “The rules thus seek to  
4 balance the right to develop new information in discovery with the need for certainty as to the legal  
5 theories.” *O2 Micro*, 467 F.3d at 1366.

6 “The dispositive inquiry in a motion to strike is thus whether the allegedly undisclosed  
7 ‘theory’ is in fact a new theory or new element of the accused product alleged to practice a particular  
8 claim that was not previously identified in the plaintiff’s contentions, or whether the ‘theory’ is  
9 instead the identification of additional evidentiary proof showing that the accused element did in  
10 fact practice the limitation. . . . If the theory is new, prejudice is ‘inherent in the assertion of a new  
11 theory after discovery has closed.’” *Finjan, Inc. v. Blue Coat Sys., Inc.*, No. 13-CV-03999-BLF,  
12 2015 WL 3640694, at \*2 (N.D. Cal. June 11, 2015) (internal citations omitted).

### 13 I. '408 Patent

14 SonicWall requests that the Court strike infringement theories concerning the '408 Patent.  
15 Mot. at 4-6. SonicWall specifically requests that the Court strike ¶¶ 146-149, 158 of Dr. Nenad  
16 Medvidovic’s report as it believes these sections contain theories that were not properly detailed in  
17 the Operative Contentions. *Id.*

18 The asserted claims of the '408 Patent recite “dynamically building, by the computer while  
19 said receiving receives the incoming stream, a parse tree . . . ” (the “Dynamically Building  
20 Limitation”) and “dynamically detecting, by the computer while said dynamically building builds  
21 the parse tree, combinations of nodes in the parse tree which are indicators of potential exploits”  
22 (the “Dynamically Detecting Limitation”). As to each limitation, SonicWall argues that Finjan  
23 improperly detailed infringement theories for the first time in the Medvidovic Report. Finjan  
24 responds that the Medvidovic Report does not offer a new theory of infringement but instead  
25 properly supplies analysis and evidence of infringement in a cohesive manner. Opp. at 5-6, ECF  
26 314 (citing *Digital Reg of Texas, LLC v. Adobe Sys. Inc.*, No. CV 12-01971-CW (KAW), 2014 WL  
27 1653131, at \*5 (N.D. Cal. Apr. 24, 2014)).

28 Upon reviewing the operative contentions and the identified sections of the Medvidovic

1 Report, the Court agrees with Finjan. *See* ECF 299-9 ¶¶ 146-149, 158 (Medvidovic Report); ECF  
2 299-10 at 17 (contentions related to Dynamically Building Limitation); ECF 314-16 at 18  
3 (contentions related to Dynamically Detecting Limitation). The Court finds that the Medvidovic  
4 Report does not represent a departure from the Operative Contentions, but rather identifies  
5 additional evidentiary proof showing that the accused element did in fact practice the limitation.  
6 *Compare* ECF 299-10 at 17 [REDACTED]  
7 [REDACTED], 18 [REDACTED]  
8 [REDACTED] ) with ECF  
9 299-9 ¶¶ 146-148 ([REDACTED]  
10 [REDACTED]  
11 [REDACTED]); *see Blue Coat Sys.*, 2015 WL  
12 3640694, at \*3 (“Plaintiff’s expert report merely elaborates on the manner in which DRTR allegedly  
13 infringes and does not amount to a last-minute disclosure of a new infringement theory.”). As  
14 required by the Patent Local Rules, Finjan has specified “where and how each limitation of each  
15 asserted claim is found within each Accused Instrumentality.” Patent L.R. 3-1(c). The Court  
16 highlights that the Patent Local Rules do not require perfect clarity, only reasonable notice that is  
17 “as specific as possible” given the information of which a plaintiff is aware. Patent L.R. 3-1(b).  
18 Finjan has met this standard.

19 **II. ’780 Patent**

20 SonicWall requests that the Court strike infringement theories concerning the ’780 Patent.  
21 Mot. at 6-7. SonicWall specifically requests that the Court strike ¶ 134 of Dr. Michael  
22 Mitzenmacher’s report as it believes this section contains theories that were not properly detailed in  
23 the Operative Contentions. *Id.*

24 Asserted claim 9 of the ’708 Patent recites “a communications engine for obtaining a  
25 Downloadable that includes one or more references to software components required to be executed  
26 by the Downloadable” and an “ID generator . . . that fetches at least one software component . . . for  
27 performing a hashing function on the Downloadable and the fetched software components . . .”  
28 (the “Fetching Limitation”). SonicWall argues that Finjan improperly detailed infringement theories

1 for the first time in the Mitzenmacher Report. Specifically, SonicWall argues that Finjan's Operative  
2 Contentions did not "reference archive files or articulate a theory for the Fetching Limitation in  
3 which a file is extracted from an archive file and then hashed." Mot. at 6. Finjan responds that the  
4 Mitzenmacher Report does not offer a new theory of infringement but instead "provides examples  
5 of several types of files that correspond to the claimed Downloadable and hashing elements." Opp.  
6 at 7.

7 Upon reviewing the operative contentions and the identified sections of the Mitzenmacher  
8 Report, the Court again agrees with Finjan. *See* ECF 299-15 ¶ 134 (Mitzenmacher Report); ECF  
9 314-22 at 2-8 (Capture ATP contentions related to Fetching Limitation); ECF 313-9 at 19-20 (same);  
10 ECF 299-14 at 2 (Email Security Appliance contentions related to Fetching Limitation). The  
11 Mitzenmacher Report states that:

12 [REDACTED]  
13 [REDACTED]  
14 [REDACTED]  
15 [REDACTED]

16 ECF 299-15 ¶ 134. This theory is adequately disclosed by Finjan's contentions. Finjan's April 2018  
17 initial contentions state that [REDACTED]

18 [REDACTED]  
19 [REDACTED]  
20 [REDACTED]" ECF 313-9 at 19-20. And  
21 Finjan's supplemental contentions from December 2019 state that [REDACTED]

22 [REDACTED]  
23 [REDACTED] ECF 314-22 at 5.  
24 Contrary to SonicWall's argument, Finjan's Operative Contentions reference archive files as well  
25 as a theory in which a file is extracted from an archive file and hashed. *See* Patent L.R. 3-1(c). The  
26 Court finds that the Mitzenmacher Report does not present a wholly new theory in ¶ 134 in violation  
27 of the Local Rules.  
28

United States District Court  
Northern District of California

1 For the foregoing reasons,

2 (1) The Court TERMINATES as moot SonicWall's Motion to Strike as to theory one  
3 ('305 Patent).

4 (2) The Court DENIES SonicWall's Motion to Strike as to theory two ('408 Patent).

5 (3) The Court DENIES SonicWall's Motion to Strike as to theory three ('780 Patent).

6 (4) The Court TERMINATES as moot SonicWall's Motion to Strike as to theory four  
7 ('154 Patent).

8 (5) The Court TERMINATES as moot SonicWall's Motion to Strike as to theory five  
9 (Infringement Theories Related to November 20 Order).

10 **IT IS SO ORDERED.**

11  
12 Dated: March 12, 2021

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14   
BETH LABSON FREEMAN  
United States District Judge

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